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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,216	07/20/2000	PETER FICKEISEN	193413USOPCT	2523
22850	7590	04/25/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	
DATE MAILED: 04/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/582,216

Applicant(s)

FICKEISEN ET AL.

Examiner

Callie E. Shosho

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-14, 16-26, 28, 31, 32, 36-52, 54, 57 and 58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-14, 16-26, 28, 31, 32, 36-52, 54, 57 and 58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. All outstanding rejections are overcome by applicants' amendment filed 6/21/04.

Upon updating the searches, a new reference came to the attention of the examiner, namely, Fickeisen et al. (U.S. 6,409,860).

In light of the new grounds of rejection as set forth below, the following action is non-final.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 9 and 22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7 of U.S. Patent No. 6,409,860 (U.S. Fickeisen et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

Fickeisen et al. disclose method of adhering a floor covering to a floor with a floor adhesive comprising aqueous composition comprising water, 20-99% polymer obtained from 60-100% C₁-C₂₀ alkyl (meth)acrylate and 0-40% additional monomer such as C₁-C₁₀ hydroxyalkyl (meth)acrylate, (meth)acrylamide, ethylenically unsaturated carboxylic acid, and dicarboxylic acid or anhydride thereof, and 1-80% filler. The polymer possesses glass transition temperature (T_g) < -25 °C.

The difference between Fickeisen et al. and the present claimed invention is (a) Fickeisen et al. is silent with respect to the gel content and number average molecular weight of the polymer and specific type of filler and (b) Fickeisen et al. disclose polymer possessing T_g < -25 °C, gel content of 0-90%, and number average molecular weight (M_n) >10,000 and composition comprising 20-99% polymer and 1-80% filler while the present claims require polymer that possesses T_g of -50 to 20 °C, gel content of 5-40%, and M_n < 30,000 and composition comprising 10-50% polymer and 50-90% filler.

With respect to difference (a), applicants' attention is drawn to MPEP 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F.2d 1017; 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines

an obvious variation of an invention claimed in the patent. (underlining added by examiner for emphasis) *In re Vogel*, 422 F.2d 438,164 USPQ 619,622 (CCPA 1970).

Consistent with the above underlined portion of the MPEP citation, attention is drawn to col.2, lines 33-34 and 40-43 of Fickeisen et al. which discloses that the polymer possesses gel content of 0-90% and $M_n > 10,000$ and to col.3, lines 30-35 of Fickeisen et al. which discloses that the filler is chalk possessing average diameter of 2-50 μm , quartz possessing average particle diameter of 3-50 μm , or mixtures thereof.

With respect to difference (b), it is noted that the T_g and M_n of the polymer of Fickeisen et al. overlap those presently claimed while the gel content of the polymer and amount polymer and filler present in the composition completely encompass those presently claimed.

It would have been within the skill level of, as well as obvious to, one of ordinary skill in the art to choose values of T_g , M_n , and gel content for the polymer, including those presently claimed, in Fickeisen et al. in order to control the properties of the polymer including temperature at which polymer forms film, viscosity of the polymer, and tackiness, respectively. Further, it would have been within the skill level of, as well as obvious to, one of ordinary skill in the art to choose amounts of polymer and filler, including those presently claimed, in order to control the viscosity, adhesion, cost, etc. of the composition.

In light of the above and in light of the overlap between the claimed composition and the composition disclosed by Fickeisen et al., it is urged that it would have been within the bounds of routine experimentation, as well as the skill level of one of ordinary skill in the art, to use

composition which is both disclosed by Fickeisen et al. and encompassed within the scope of the present claims, and thereby arrive at the claimed invention from Fickeisen et al.

4. Claims 9 and 22 directed to an invention not patentably distinct from claims 1 and 7 of commonly assigned Fickeisen et al. Specifically, although the conflicting claims are not identical, they are not patentably distinct for the reasons set forth in paragraph 3 above.

5. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

Commonly assigned U.S. 6,409,860), discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

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6. Claims 9 and 22 are rejected under 35 U.S.C. 103(a) as being obvious over Fickeisen et al. (U.S. 6,409,860).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

For an explanation of the rejection see paragraph 3 above.

Claim Objections

7. Claims 16-17 and 43-44 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 16, which depends on claim 9, discloses that the monomeric unit present in the polymer is present in an amount of 0-40%, while claim 9 discloses that polymer “further comprises” the monomer unit. Thus, claim 16 fails to further limit the scope of the claim on which it depends given that while claim 9 requires that the polymer must comprise the monomer unit, claim 16 additionally encompasses polymer that does not comprise the monomer unit, i.e. present in amount of 0%. Thus, claim 16 is broader than claim 9 given that the polymer of claim 9 only includes polymer that comprises the claimed monomer unit while the polymer of claim 16 includes polymer that comprises the monomer unit and polymer that does not comprise the monomer unit.

Similar objection is made with respect to claim 17 which also depends on claim 9 and recites similar claim language to claim 16 and with respect to claims 43-44 which each recite similar claim language to claim 16 and which each depend on claim 42.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 9-14, 16-26, 28, 31-32, 36-52, 54, and 57-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fickeisen et al. (U.S. 6,409,860).

Fickeisen et al. disclose method comprising adhering floor covering such as textile covering, linoleum covering, etc. to floor with floor adhesive comprising aqueous composition that comprises water, 20-99% polymer, 1-80% filler, and additive including wetting agent, dispersant, and thickener. The composition contains essentially no organic compounds having boiling point of less than 260 °C. The polymer is obtained from 60-100% monomer including C₁-C₂₀ alkyl (meth)acrylate and possesses number average molecular weight >10,000, gel content of 0-90% (particularly preferably 20-70%, and very particularly preferably 40-60%), and glass transition temperature < -25 °C. The polymer is also obtained from 0-40% additional monomers including C₁-C₁₀ hydroxyalkyl (meth)acrylate, (meth)acrylamide, ethylenically unsaturated

carboxylic acid, and dicarboxylic acid or anhydride thereof. It is further disclosed that the polymer is present in the form of a polymer dispersion with solids content of 40-80%. The filler includes chalk having mean diameter of 2-50 μm and/or quartz powder having mean diameter of 3-50 μm . It is further disclosed that the adhesive is applied to substrate such as wood, stone, concrete, ceramic tiles, and metal surfaces (col.1, lines 7-11, 37-41, and 46-59, col.2, lines 26-28, 33-34, and 40-43, col.3, lines 24-26, 30-35, and 40-45, and col.3, line 61-col.4, line 3).

It is noted that the Tg and Mn of the polymer of Fickeisen et al. overlap those presently claimed while the gel content of the polymer and amount polymer and filler present in the composition completely encompass those presently claimed.

It would have been within the skill level of, as well as obvious to, one of ordinary skill in the art to choose values of Tg, Mn, and gel content for the polymer, including those presently claimed, in Fickeisen et al. in order to control the properties of the polymer including temperature at which polymer forms film, viscosity of the polymer, and tackiness, respectively. Further, it would have been within the skill level of, as well as obvious to, one of ordinary skill in the art to choose amounts of polymer and filler, including those presently claimed, in order to control the viscosity, adhesion, cost, etc. of the composition.

In light of the above, it is clear that while Fickeisen et al. fails to exemplify the presently claimed composition nor can the claimed composition be "clearly envisaged" from Fickeisen et al. as required to meet the standard of anticipation (cf. MPEP 2131.03), nevertheless, in light of the overlap between the claimed composition and the composition disclosed by Fickeisen et al., it is urged that it would have been within the bounds of routine experimentation, as well as the

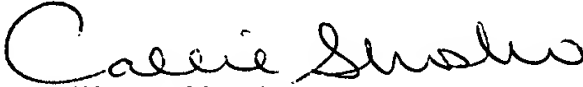
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skill level of one of ordinary skill in the art, to use composition which is both disclosed by Fickeisen et al. and encompassed within the scope of the present claims, and thereby arrive at the claimed invention.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
4/15/05